

RCE & AMENDMENT  
Serial No. 10/612,079  
Docket No. ORW01-GN003

### REMARKS

#### Introductory Comments

Claims 41-46, 48-76, and 105 are pending in the present application. Claims 41, 57, and 63 have been amended. Claims 1-40 and 47 have been cancelled.

A Request for Continued Examination has been concurrently filed with the instant Amendment.

Reconsideration of the application is respectfully requested.

#### Instant Office Action – 35 U.S.C. § 102 Rejections

Claims 1-14, 17, 20, 41-54, 57, and 60 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 6,592,622 to Ferguson ("Ferguson"). This ground of rejection is now moot as to claims 1-14, 17, 20, but has been fully overcome with respect to claims 41-54, 57, and 60 by the amendments to claim 41.

Claim 41 has been amended to recite in part, a lining mounted to at least one of the tibial component and the femoral component in the prosthetic knee joint, and remote from native connective tissue, so that the lining is between the tibial component and the femoral component approximate a prosthetic intercondylar channel of the femoral component to supplement periarticular stability between the tibial component and the femoral component. In other words, the lining is not mounted to native connective tissue. Clearly, Ferguson does not disclose or suggest such a lining.

In the June 5 Office action, the Examiner asserts that the "band assembly" of Ferguson "is capable of being mounted to at least one of a tibial component 10 so that the lining is between the tibial component and a femoral component and approximate a prosthetic intercondylar channel."<sup>1</sup> But the Examiner's assertion by itself proves that Ferguson does not anticipate Applicant's claims 41-54, 57, and 60.<sup>2,3</sup> Instead, the

<sup>1</sup> June 5, 2007 Office action, p. 2.

<sup>2</sup> See M.P.E.P. § 2131 "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987).

<sup>3</sup> See M.P.E.P. § 2131 "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989).

RCE & AMENDMENT  
Serial No. 10/612,079  
Docket No. ORW01-GN003

Examiner is really relying on obviousness to assert that the structure of Ferguson somehow inhibits allowance of Applicant's claims. Even taking this obviousness argument into account, Applicant's claims 41-54, 57, and 60 are in condition for allowance.

The mere fact that Ferguson could be modified does not render obvious Applicant's claims unless Ferguson also suggests the desirability of the combination.<sup>4</sup> Although it may be alleged that Ferguson is capable of being modified as recited in Applicant's claims, one skilled in the art must be motivated to do so. But those skilled in the art would not have been motivated to modify Ferguson as recited in Applicant's claims. If anything, Ferguson teaches away from Applicant's claims.

Those portions of Ferguson cited to by the Examiner teach a structure entirely at odds with the structure claimed by Applicant. Ferguson teaches using a resorbable material connected to a patient's native connective tissue to spur on native connective tissue growth that connects bone to the tibial prosthetic component.<sup>5</sup> But Applicant is not at all interested in forming connective tissue that couples soft tissue to a prosthetic component. If anything, Applicant's lining avoids the formation of coupling soft tissue to prosthetic components. Ferguson, on the other hand, is directed to the exact opposite situation and teaches those skilled in the art of a preference for using resorbable materials to form bridges mounted to native tissue that eventually transform into connective tissue coupling this soft tissue to prosthetic components.<sup>6</sup> In this regard, Ferguson clearly teaches away from Applicant's claims, which recite a lining remote from connective tissue. If the Examiner disagrees, Applicant respectfully requests the Examiner point to the disclosure of Ferguson stating that the resorbable lining not mounted to native connective tissue.

<sup>4</sup> See M.P.E.P. § 2143.01, citing *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990).

<sup>5</sup> See U.S. Patent No. 6,592,622 at column 5, lines 1-59.

<sup>6</sup> See U.S. Patent No. 6,592,622 at column 1, lines 7-9, TECHNICAL FIELD OF THE INVENTION section, "The present invention relates generally to a prosthesis, and more particularly to an apparatus and method for securing soft tissue to an artificial prosthesis."

RCE & AMENDMENT  
Serial No. 10/612,079  
Docket No. ORW01-GN003

35 U.S.C. § 103 Rejections

Claims 15, 16, 18, 19, 21, 22, 33-40, 55, 56, 58, 59, 61, and 62 stand rejected under 35 U.S.C. § 103(a) as allegedly being obvious over U.S. Patent No. 6,592,622 to Ferguson ("Ferguson") in view of U.S. Patent No. 6,616,698 to Scarborough ("Scarborough"). This ground of rejection is moot as to claims 15, 16, 18, 19, 21, 22, 33-40, and has been fully overcome for claims 55, 56, 58, 59, 61, and 62 by the amendments to claim 41.

As discussed previously, claim 41 has been amended to recite in part, a lining mounted to at least one of the tibial component and the femoral component in the prosthetic knee joint, and remote from native connective tissue, so that the lining is between the tibial component and the femoral component approximate a prosthetic intercondylar channel of the femoral component to supplement periarticular stability between the tibial component and the femoral component. In other words, the lining is not mounted to native connective tissue. Ferguson does not disclose or suggest Applicant's claimed lining, nor using a reabsorbable material in any form other than to form soft connective tissue. Moreover, Ferguson does not disclose or suggest using a reabsorbable lining remote from connective tissue.

In the June 5 Office action, the Examiner incorrectly asserts that Ferguson discloses all of the limitations of claims 55, 56, 58, 59, 61, and 62, but for "an antibiotic agent such as gentamicin, a clotting factor and osteogenic materials such as stem cells and transforming growth factor."<sup>7</sup> As discussed previously, Ferguson does *not* disclose all the limitations of old claim 41 or claim 41 as amended. Thus, the Examiner must have been relying on obviousness to assert that the structure of Ferguson somehow inhibits allowance of Applicant's claims. But the Examiner's obviousness argument is not well founded.

The mere fact that Ferguson could be modified does not render obvious Applicant's claims unless Ferguson also suggests the desirability of the combination.<sup>8</sup> Although it may be alleged that Ferguson is capable of being modified as recited in

<sup>7</sup> June 5, 2007 Office action, p. 3.

<sup>8</sup> See M.P.E.P. § 2143.01, citing *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990).

RCE & AMENDMENT  
Serial No. 10/612,079  
Docket No. ORW01-GN003

PAGE 17/17 \* RCVD AT 6/13/2007 1:01:05 PM [Eastern Daylight Time] \* SVR:USPTO-EFXRF-3/10 \* DNIS:2738300 \* CSID:513 381 0205 \* DURATION (mm-ss):24-16

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